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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT: Stefan Alfons Hepper et al.

SERIAL NO.: 10/016,995

ART UNIT: 2155

FILED: 12/14/2001

EXAMINER: S. QURESHI

TITLE: AUTOMATED CONTENT PUBLISHING

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Real Party In Interest

The real party in interest is International Business Machines Corporation of Armonk, New York, the assignee of the entire right, title and interest in this application.

Related Appeals and Interferences

There are no other appeals or interferences known to Appellant, the Appellant's legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

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01 FC:1254 1590.00 DP

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02 FC:1402 500.00 DA

Status of Claims

This appeal is directed only to claims 6, 7 and 17, which are all dependent claims. The reason for why the rejection of only dependent claims is being appealed at this time is set forth below in the Status of Amendments section of this brief.

Status of Amendments

An amendment was filed after the final rejection, concurrently with the Notice of Appeal. More than five months after the filing of this Amendment Under 37 C.F.R. 1.116, the Examiner acted on that paper, in a paper entitled Advisory Action Before Filing of an Appeal Brief. The Amendment Under 37 C.F.R. 1.116 was not entered. Thus, only certain of those claims that represent combinations of elements actually considered by the Examiner (dependent claims 6, 7 and 17) are presented herein for consideration on appeal.

The Advisory Action for the first time, after two previous rejections, raises an issue concerning clarity of claim 1, from which appealed claims 6 and 7 depend. That newly raised issue is addressed below.

Summary of the Invention

Appellants' invention, as set forth in dependent claims 6, and 17, is directed to a method (and a computer system, respectively in claim 17), for operating a computer system comprising having at least one content provider (Fig. 1, reference numerals 11, 12, 13 and Fig. 2 numeral 13 (as

submitted for clarification in the Amendment received on March 22, 2004)).

The content providers (Fig. 1, reference numerals 11, 12, 13) provide content to a user (Fig. 2, reference numeral 24, Specification, Page 6, lines 1-3)) coupled via a portal (Fig. 1, numeral 14, and most of the components in Fig. 2) which may also be coupled to a user.

The at least one content provider offers new content to the portal (Specification, page 2, lines 5-7; Page 2, lines 16-19).

The portal compares credentials of the at least one content provider with stored credentials (Fig. 2, numeral 16; Specification, Page 2, lines 4-5) of registered content providers; and the portal accepts or rejects at least a particular provider included in the at least one content provider based on the stored credentials.

The portal checks the new content, and the portal accepts or rejects the new content (Specification Page 5, lines 13-19; Specification Page 6, lines 11-15).

Appellants' invention as set forth in claim 7 calls for doing the evaluation of the new content being performed semi-automatically or fully automatically (Specification, page 3, lines 1-3; page 18, lines 18-19).

Claim 17, by including the recitation of claim 1, includes:

means for offering new content to the portal (at least Fig. 1, reference numerals 11, 12 and 13; Fig. 2, reference numeral 13; and Specification, page 3, line 21 to page 4, line 2; Specification, page 5, lines 7 to 12.

means for comparing credentials of said at least one content provider with stored credentials of registered content providers (at least Specification, page 2, lines 4-5, Page 4, lines 14-19; Fig. 2, reference numeral 16)

means for accepting or rejecting said at least one content provider (at least Specification, page 2, lines 4-5, Page 4, lines 14-19; Fig. 2, reference numeral 17)

checking means for the portal to check the new content (at least Fig. 2, reference numeral 21; Specification, page 5, lines 14-15.

Grounds for Rejection to be reviewed on Appeal

Claims 6, 7 and 17 were finally rejected under 35 U.S.C. §102(e) as anticipated by Oliver et al.

For the first time, the language of claim 1 was indicated as being indefinite in the Advisory action.

Issues Presented for Review

1. The central issue presented for review is: Whether a reference which discloses at most only registering new users

and not content providers, can anticipate claims to evaluating new content provided by the content providers for the purpose of accepting or rejecting the new content?

2. Another issue presented for review is: Whether a reference which discloses at most only registering new users and not content providers, can anticipate a claim to evaluating new content provided by the content providers for the purpose of accepting or rejecting the new content, semi-automatically or automatically (claim 7)?

3. The issue presented for the first time in the Advisory Action is whether the language that is interpreted by the examiner that "the portal may or may not be coupled to the user" makes the claim language unclear, when it is common practice for users to connect or not to connect to a portal via the Internet or other network?

Grouping of Claims

Method claims 6 and 7 constitute a first group of claims. Due to their different elements, as set forth in detail below, it is believed that these claims are separately patentable, and do not stand or fall together. Apparatus Claim 17 constitutes a separate "group" of claims, and is separately argued herein. However, it is noted that all claims appealed were rejected on the same basis, as noted below.

ARGUMENT

THE REJECTION UNDER 35 U.S.C. 102.

Claims 6, 7 and 17 were rejected under 35 U.S.C. 102(e) as anticipated by Oliver et al. (U.S. Patent Publication No. 2002/0133412). Set forth below is exactly what Oliver et al. does teach. Then, what is set forth are the elements of each argued claim that are not anticipated or even remotely suggested by Oliver et al. It will be demonstrated that Oliver et al. does not anticipate the claims, because their elements, as specifically set forth below, are simply not found in Oliver et al.

WHAT OLIVER ET AL. TEACHES

Oliver et al. does not teach or even remotely suggest any of the elements of claims 6, 7 and 17 as set forth below. Indeed, Oliver et al. specifically teaches throughout the text, a system for managing client accounts and controlling access to resources over data networks. Oliver et al. is directed to sharing client information and charges among a plurality of service providers. A client who is registered with one of the service providers (the "home provider") is allowed to access the resources of the other service providers ("outside providers") that are part of the system. Oliver et al. teaches a settling means adapted to allow the system to settle accounts among service providers by charging the home provider for access by its clients to the resources of the outside providers. Further Oliver et al. teaches a payment means adapted to assure that the outside providers are then paid for

that access through the system, and a sharing means adapted to allow the system to allow the providers to share users without requiring an open account for each user at each provider. In addition, Oliver et al. teaches a verification means adapted to allow each provider to determine if a particular client is a member of the system, verify that the client has authenticated at his home provider, and determine this client's access and service privileges and criteria.

Thus, it will be demonstrated below that not only does Oliver et al. fail to suggest what Appellants have claimed, but Oliver et al. solves a completely different problem, for a completely different reason. Under these circumstances the conclusion that Appellant's invention is anticipated by Oliver et al. has no basis in fact or law.

It is respectfully submitted that the Examiner's reliance on portions of Oliver et al. discussed below, to reject the claims, is badly misplaced. In fact, it is respectfully submitted that either the Examiner has not carefully read these sections, or the Examiner simply does not understand what these sections are teaching. In either event, the rejection is simply not justified and represents one of the most obvious misunderstandings of a reference that the undersigned has seen in more than twenty-five years of successful practice before the United States Patent and Trademark Office.

WHAT THE CLAIM ELEMENTS RECITE: ARGUMENTS FOR SPECIFIC CLAIMS

Claim 6

Claim 6 is directed to a method for operating a computer system and specifically recites the elements of:

having at least one content provider for providing content to a user coupled via a portal which may also be coupled to a user;

said at least one content provider offering a new content to the portal;

the portal comparing credentials of said at least one content provider with stored credentials of registered content providers;

the portal accepting or rejecting at least a particular provider included in said at least one content provider based on said stored credentials.

the portal checking the new content, and the portal accepting or rejecting the new content.

The undersigned has carefully and diligently reviewed Oliver et al., and has found not a single reference to, or even the most remote suggestion of a portal checking new content. The Examiner's statements, on page 4, paragraph 5, of the Final Office Action, referring to paragraph [0162] of Oliver et al. is

simply wrong, as is the Examiner's characterization of various other parts of Oliver et al., as this is not what Oliver et al. states.

Indeed, Oliver et al. in paragraph [0162], states:

[0162] This section describes the TVS applications programming interface (API). This interface is written in the C programming language for wide applicability to most Web servers written in C, C++, or Objective C. Using this interface, programmers do not have to interact with the TVS wire protocol, or with the details of the internal data structures. Since Clickshare is still in its early development, this interface insulates programmers from the many changes that will occur in the low-level design. The TVS API was developed and written for the Unix(tm) operating system. The API uses widely-available and well-documented Unix(tm) features and functionality, such as Berkeley-type sockets. Clickshare intends that TVS be made available first in the Unix(tm) environment, but does not preclude porting the client API to other operating environments (notably, Microsoft Windows NT).

This statement of Oliver et al. has absolutely nothing to do with the recitations of claim 6, as set forth above, and more specifically this paragraph has absolutely nothing to do with "the portal checking the new content, and the portal accepting or rejecting the new content."

The Examiner also relies generally on paragraphs [0133] and [0037] of Oliver et al. (Final Office Action, page 2, last two paragraphs) in rejecting claim 6. These paragraphs of Oliver et al., reproduced below, also have nothing whatsoever to do with the recitations of claim 6, as noted above.

[0133] This service logs user transactions occurring at all Clickshare Service Providers sites, in real time. The major component of this service is the Logging Facility--a large database storing all transaction records for production billing. This facility can be operated behind a firewall, due to the design of the Facility interface server.

[0037] BILLING AGENTS/SERVICE PROVIDERS--Consumers have preexisting, ongoing credit relationships with billing agents or service providers who agree to become Clickshare Service Providers. In exchange for a negotiated share of the "Clickstream" revenue from information sales, or for other consideration, these service providers assume responsibility for servicing and billing consumer or enterprise end users and for authenticating the user at the start of a Clickshare/TVS session. Examples include: Internet Service Providers, newspapers, specialized publishers, online services, telephone companies, cable and utility companies, credit-card issuing banks, health-care providers, retailers, other consumer-credit entities, network or other service providers and other enterprises.

In view of the above, it is clear that the rejection of Claim 6, based on Oliver et al. can not be maintained, and a reversal of the Examiner by the Board is respectfully requested.

Claim 7

Claim 7, which depends from Claim 6, specifically recites among its other elements that "the evaluation of the new content is performed semi-automatically or fully automatically." Again, the Examiner is relying on paragraph [0162] of Oliver et al., reproduced in its entirety above. Again, since the portions of Oliver relied upon by the Examiner do not teach or suggest the evaluation of new content, there is nothing in Oliver et al. which can teach or suggest evaluating the new content semi-automatically or fully automatically. Thus, it is submitted that Claim 7 is also directed to patentable subject matter, and the rejection should be overturned by the Board.

Claim 17

Claim 17, is an apparatus claim somewhat similar to method claim 6. Claim 17 specifically recites:

A computer system comprising at least one content provider for providing content to a user which is coupled to a portal which may be coupled to a user wherein said at least one content provider comprises means for offering a new content to the portal, wherein the portal comprises means for comparing credentials of said at least one content provider with

stored credentials of registered content providers, and wherein the portal comprises means for accepting or rejecting said at least one content provider.

Claim 17 states that the system further comprises:

checking means for the portal to check the new content, and the portal accepting or rejecting the new content based on a determination of said checking means.

In addition to relying on paragraphs [0037] and [0133] of Oliver et al., which are specifically reproduced above in their entireties, the Examiner, on Page 6, third paragraph specifically relies on paragraphs [0074] and [0120] of Oliver et al. These paragraphs of Oliver et al. state:

[0074] UNIVERSAL ACCESS--Publishers who seek to charge users on a subscription basis by definition exclude the vast majority of potential users who would buy a portion of the web site's offerings on a "per-click" basis. Clickshare, uniquely, offers the opportunity to "have it both ways." Just as conventional newspaper and magazine publishers have subscribers and single-copy sales, the Clickshare publisher can have subscribers, but also vend information to visiting Clickshare users "by the click." In the proprietary online world (West, Lexis-Nexis, Compuserve, Knight-Ridder-Dialog) this has not been technically feasible because of the lack of a universal public network, such as the Internet, that takes care of site access.

Clickshare provides the vicarious billing relationship.

[0120] TVS introduces the notion of a "session" into the World Wide Web. Once a user is authenticated by his "home" Publishing Member, that Publishing Member provides user profile information to its TVS server, which returns an authentication token that is valid for a restricted period of time. Once given this token, the user can access any TVS-enabled HTTP server for the duration of validity without reauthentication. This time period is the "session". The user may directly end his session prior to the pre-determined time-out, but is not required to do so. Further, upon time-out-out, Clickshare can return the user to his "home" Publishing Member for re-authentication transparently. Thus, sessions can be concatenated as well.

Again, the Examiner's reliance on Oliver et al. is simply wrong. The above portions of Oliver et al. simply do not teach or suggest a checking means for the portal to check new content, and the portal accepting or rejecting the new content based on a determination of said checking means. Thus, claim 17 is not anticipated or rendered obvious by Oliver et al. The rejection of claim 17 should be overruled by the Board.

The §112, ¶2 Issue Raised for the First Time in Advisory Action

The Examiner has raised for the first time, after the filing of the Notice of Appeal, an issue concerning the language of claim 1, which is incorporated into claim 6, because claim 6 depends from claim 1. Specifically, the Examiner has stated that language in claim 1 is interpreted by the Examiner to mean that "the portal may or may not be coupled to the user" and thus makes the claim language unclear.

There are three arguments that Applicants submit in response.

1. The Examiner is reopening prosecution by for the first time raising this issue after a Notice of Appeal has been filed. Any determination on the merits of this issue should be left until after the other issues herein are decided, so that the Applicant has an opportunity to fairly address this issue.

2. On the merits, the claim language is actually technically correct. A user may or may not connect to a portal as user habits or messages from the portal dictate, so the portal may or may not be coupled to a user. This is merely a reality of present day network communication techniques. There is nothing indefinite about the language.

3. If the Examiner persists in pursuing this issue, it is very likely that a simple amendment to the claim language can be agreed upon to settle the issue.

It is respectfully submitted that claim 1 (and thus claims 6 and 7) are definite within the meaning of 35 U.S.C. §112.

Conclusion

It has been shown herein that claims 6, 7 and 17 are not anticipated by or obvious over Oliver et al. Further, has been shown that the language of claim 1 is not indefinite. Accordingly, reversal of these rejections by the Board is respectfully requested.

Fees

Please charge deposit account no. 50-0510 in the amount of \$500 for the filing of this paper. A duplicate of this page is attached. An extension of time of four months for the filing of this paper is respectfully requested. A check in the amount of \$1,590 to cover the fee is submitted herewith.

Respectfully submitted,

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6/6/2005
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wherein said at least one content provider comprises means for offering a new content to the portal, wherein the portal comprises means for comparing credentials of said at least one content provider with stored credentials of registered content providers, and wherein the portal comprises means for accepting or rejecting said at least one content provider .

17. (PRESENTLY APPEALED) The computer system of claim 10 further comprising checking means for the portal to check the new content, and the portal accepting or rejecting the new content based on a determination of said checking means.